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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Kupa, Inc.

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Serial No. 76/411,536

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G. Donald Weber, Jr. for Kupa, Inc.

William. T. Verhosek, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Cissel, Seeherman and Bucher, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 4, 2002, applicant, a California corporation, filed the above-identified application. In the heading of the application the mark is identified as "PURPLE (The Color)." In the first line of the application, applicant states that it "has adopted and is using the color purple as a trademark for… [an] …"electric nail filing system." Applicant goes on to state that the mark was first used in connection with these products on June 1, 1984 and was first used in interstate commerce in connection with them

on July 1, 1984. Applicant seeks registration pursuant to the provisions of Section 2(f) of the Trademark Act.

What appears to be the drawing page submitted with the application presents applicant's name, address, date of first use and goods at the top, and at the center of the page appear the words "The Color PURPLE."

The specimen of use is a printed advertisement for applicant's electric nail-filing tool, an implement used in providing manicures and pedicures. A color photograph of the product in displayed under the interesting admonition "Except No Imitations!" The housing for the machine is purple, and a handwritten notation "THE COLOR PURPLE" is circled, with an arrow pointing to the purple housing shown in the illustration.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that applicant's mark, "The Color PURPLE," is merely descriptive of a characteristic or feature of applicant's goods, namely that they are colored purple. Applicant was advised that its allegation of five years' use is insufficient evidence of acquired distinctiveness, but that the Examining Attorney would consider additional evidence relating to secondary meaning.

In addition to refusing registration, the Examining Attorney addressed several informalities. He noted that the mark displayed in the drawing, i.e., the words "The Color PURPLE," does not appear on the specimen, and required applicant to submit a specimen that shows use of the mark as it appears on the drawing. He also required applicant to amend the identification-of-goods clause to eliminate the indefinite term "systems," and suggested that applicant might adopt, if accurate, "electric nail filing machine," in Class 7. Additionally, applicant was advised that the drawing was unacceptable because it is not typed entirely in capital letters.

On the same day that the first Office Action was mailed, the Office received a communication from applicant noting that on the filing receipt it received from the Office, the mark was listed as "stylized words, letters, or numbers." Applicant advised that this designation was not correct, and explained that the mark is the color purple, rather than a word mark.

Responsive to the Office Action, applicant amended the identification-of-goods clause to read "electric nail filing machine in International Class 07," and argued that the refusal based on descriptiveness was not well taken. Applicant argued that even though the Examining Attorney

understood that applicant's intention is to register the color purple as applied to its products, he was treating the mark as if it were a word mark, rather than as the color mark that it is. Contending that the corrected filing receipt issued by the Office on August 6, 2002 identifies the mark as a sensory mark with no drawing, applicant argued that even if it "did submit a so-called 'drawing page,' the Examining Attorney was officially on notice that the drawing page should have been ignored, as such, and treated as a description of the mark and that the specimen submitted with the application should have been considered as the mark to be examined." Applicant took issue with the Examining Attorney's statement that applicant could not amend the drawing to conform to the display on the specimens because the character of the mark would be materially altered. Applicant offered to provide a color strip or a color swatch in lieu of a drawing page, if one were required by the Examining Attorney, and contended that the Examining Attorney was aware of what applicant's mark is, and therefore that amending the drawing would not constitute a material alteration. Applicant requested that the Examining Attorney reconsider the refusal to register, as well as the requirement for

substitute specimens, "which the Examining Attorney admits [are] based upon an unintended situation."

As a final matter, apparently in response to the Examining Attorney's request for information relating to acquired distinctiveness, applicant provided information relating to the length of the use of its mark, its advertising expenses and sales amounts.

The Examining Attorney accepted applicant's amendment and evidence of distinctiveness, and noted that because applicant had not submitted an acceptable typed drawing of the mark, the mark would be considered to be in special form. With respect to applicant's argument that the drawing page should not be treated as such, but only as a description of the mark, the Examining Attorney argued that if no drawing had been submitted, applicant should have been denied a filing date. Maintaining his position that the mark applicant applied to register is displayed on the drawing page as a word mark, he made final the requirement for a substitute specimen showing that mark used in connection with applicant's goods.

Applicant timely filed a Notice of Appeal. Applicant then filed its appeal brief, the Examining Attorney filed his, and applicant filed a reply brief. Applicant did not request an oral hearing before the Board.

Although the sole issue before us in this appeal is whether the Examining Attorney's requirement for substitute specimens is proper, the question that applicant posits is whether applicant was required to submit a drawing with its application. Applicant asserts that it was not required to do so, and therefore its specimen should be considered to be acceptable.

Applicant's position is clear: the Examining Attorney clearly understood that applicant intended to register the color purple, as applied to electric nail filing machines, rather than the words shown on what the Examining Attorney views as the drawing page, but he is "slavishly" adhering to form over function by treating the mark as a word mark just because what he views as the drawing page depicts it as such. Applicant contends that what it provided was a description of its mark, rather than a drawing of it. Applicant argues that the Examining Attorney's contention that color marks must be depicted in a drawing "is in error. A black and white drawing, i.e., color lining is not required in sensory marks…" (brief, p. 6.)

Applicant's arguments are not well taken.

Section 1(a)(2), which provides for the filing of applications based on use in commerce, states that the application must include, inter alia, a drawing of the

mark. The only exception to this is found in Trademark Rule 2.52(a)(3), which provides that the applicant is not required to submit a drawing if the applicant's mark consists only of a sound, a scent, or other completely non-visual matter.

Trademark Manual of Examining Procedure Section 1202.05(d) (3d ed., revised June 2002) is equally clear:

> All marks, other than sound and scent marks, require a drawing. TMEP Section 807. An application for a color mark that is filed without a drawing will be denied a filing date. 37 C.F.R. Section 2.21(a)(3). Similarly, an application for a color mark with a proposed drawing page that states "no drawing" or sets forth only a written description of the mark will be denied a filing date. The drawing provides notice of the nature of the mark sought to be registered. Only marks that are not capable of representation in a drawing, such as sound or scent marks, are excluded from the requirement for a drawing. Color marks are visual, and should be depicted in a black and white drawing, accompanied by a detailed written description of the color and how it is used. 37 C.F.R. Section 2.52(a)(2)(v); TMEP Sections 807.09(a) and (c).

Section 1202.05(d) goes on to explain the proper manner in which to depict color marks such as the mark applicant states it intended to apply to register:

> 1202.05(d)(i) Drawings of Color Marks in Trademark Applications
>
> In most cases, the drawing will consist of a representation of the product or product package. The drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. 37 C.F.R. Section 2.51. A depiction of the object on which the color is used is

> needed to meet this requirement. The object depicted on the drawing should appear in broken lines. The broken lines inform the viewer where and how color is used on the product or package, while at the same time making it clear that the shape of the product, or the shape of the package, is not claimed as part of the mark. 37 C.F.R. Section 2.52(a)(2)(ii); TMEP Section 807.10. In the absence of a broken-line drawing, the Office will assume that the mark is a composite mark consisting of the product shape, or the packaging shape, in a particular color.

Contrary to applicant's repeated assertion, the color of applicant's goods does not constitute a "sensory mark," for which no drawing would be necessary. Rule 2.52(a)(3) restricts such marks to sounds, scents, or "other completely non-visual marks." Color marks are nothing if not visual. The rule permitting omission of the drawing requirement when the mark is a sound, a scent, or something else that is non-visual has no application to the facts in the case before us.

We note further that the Board is not bound by the mischaracterization of applicant's mark in the "corrected" filing receipt. To permit a clerical error to determine whether the legal requirements of the statute and the rules have been met would clearly be unwarranted. Applicant cites no legal authority for such a proposition.

We therefore cannot adopt applicant's argument that because no drawing is required in this case, the page submitted with the application which otherwise would appear

to be a drawing should be considered to be a statement describing the mark. If this were the case, as noted above, the application should not even have been given a filing date.

As an additional comment, even if a description of a color mark were allowed to be submitted as a "drawing," we would find that the words "The Color PURPLE" which appear in the center of the drawing page represent a word mark, rather than a description. One looking at these words on the drawing page would not be made aware that the applicant is seeking to register as a mark a purple color to be applied to the entirety of applicant's product. The very terseness of the phrase "The Color PURPLE," as well as the odd use of capital letters, make it appear to be a word mark. In addition, the phrase, "the color purple' has some significance as the title of a well-known book and movie, and frequently such titles are used as trademarks for other goods and services.

As noted previously, applicant argues that the Examining Attorney was well aware of the mark for which it intended to apply. However, one could reach this conclusion only upon a viewing of the entire application, and specifically, the specimen, which shows applicant's

product colored purple, with the words “THE COLOR PURPLE’ handwritten on the specimen to point to that fact.

Under In re ECCS Inc., 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996), if there was an “internal inconsistency” between the mark shown in the drawing and the one shown in the specimen, one would look to the specimen to determine what the mark actually was. However, subsequent to the ECCS decision, the U.S. Patent and Trademark Office issued a notice of final rulemaking by which certain of the rules applicable to drawings were amended. The stated purpose for such amendments was “to prohibit amendments that materially alter the mark on the original drawing.” 64 Fed. Reg. 48900, 48902 (Sept. 8, 1999). In particular, Trademark Rule 2.52(a) was amended to add the language “A drawing depicts the mark sought to be registered.” Now, if an application is filed with a drawing page showing a mark which differs from the mark in the written application or the specimen, the drawing controls, and the drawing may not be amended if the amendment is a material alteration of the mark shown on the drawing page. See Trademark Rule 2.72(a) and In re Who? Vision Systems, Inc., 57 USPQ2d 1211 (TTAB 2000).

In the case at hand, amending the drawing would not be appropriate because a proper drawing showing applicant’s

nail filing machine in dotted lines with lining for the color purple would constitute a material alteration of the original drawing depicting the mark as words. Clearly the commercial impressions of the words “The Color PURPLE” and the color purple applied to the entire surface of a nail filing machine are different. Applicant does not argue otherwise.

For the same reason, the mark shown on the specimen submitted with the application does not agree with the mark shown on the drawing, so the requirement for a substitute specimen which does agree with the drawing is proper.

DECISION: The requirement under Section 1 of the Act for specimens which show the mark sought to be registered used in connection with the goods set forth in the application is affirmed.